

REMARKS

In the Office Action mailed August 9, 2004, Claims 14-20 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. Claims 14-20 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-7 of U.S. Pat. No. 6,696,383. The Examiner also contends that the Oath or Declaration is defective.

Although applicants acknowledge the Examiner's statement in the paragraph spanning pages 2 and 3 of the instant Office Action regarding her examination methodology, they do not acquiesce in any claim construction based upon that statement. Applicants respectfully remind the Examiner that claim interpretation is a matter for the courts. *See, Markman v. Westview Instruments*, 517 U.S. 370,372 (1996).

Rejections under 35 U.S.C. §112, second paragraph

Claims 14-20 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite. The Examiner contends that the recitation of "transition metal salt" renders Claim 14 indefinite and queries the reference to "metal cyanide salt" in Claim 16.

As to Claim 14, applicants by this amendment have removed the word "salt" from the recitation of M³.

As to Claim 16, applicants note that the word "salt" was removed from the phrase "at least one metal cyanide" in the Preliminary Amendment filed November 19, 2003, thus there is no reference to "metal cyanide salt" as contended by the Examiner in the instant Office Action. However, applicants have amended Claim 16 to recite that the at least one metal cyanide is "hexacyanocobalt (III)" to remove any confusion.

Applicants submit that because of the above-detailed changes, the claims are in compliance with 35 U.S.C. §112, second paragraph, and respectfully request the Examiner reconsider and reverse her rejection of Claims 14-20 under 35 U.S.C. §112, second paragraph, as being indefinite.

Rejections under judicially created doctrine of obviousness-type double patenting

Claims 14-20 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-7 of U.S. Pat. No. 6,696,383.

Applicants respectfully disagree with the Examiner's contention that the instant claims are directed to substantially the same invention as that claimed in the '383 patent. However, in the interest of expediting prosecution of the instant application and in keeping with the spirit of the PTO's Patent Business Goals (PBG) 65 Fed. Reg. 54603 (September 8, 2000), applicants herewith submit a terminal disclaimer disclaiming any portion of the term of the instant application exceeding that of the parent patent.

Applicants contend that such terminal disclaimer obviates any cause for rejection of the instant claims as being unpatentable over those of U.S. Pat. No. 6,696,383 and respectfully request the Examiner reconsider and remove her rejection of Claims 14-20 under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-7 of U.S. Pat. No. 6,696,383.

Oath or Declaration

The Examiner contends at page 2 of the instant Office Action that the oath or declaration is defective because:

Non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Applicants submit herewith a new declaration remedying the deficiencies noted by the Examiner.

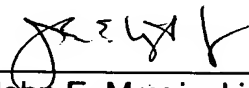
Conclusion

Applicants have amended Claims 14 and 16. Such amendment is to be construed as "truly cosmetic" and is not believed to narrow the scope of the claims or raise an estoppel within the meaning of *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al.*, 535 U.S. 722 (2002).

Applicants also contend that such claim amendments add no new matter and find support in the specification.

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 14-20. If the Examiner is of the opinion that the instant application is in condition for other than allowance, she is invited to contact the applicants' Attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

By: 

John E. Mrozinski, Jr.
Attorney for Applicant
Reg. No. 46,179

Bayer MaterialScience LLC
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
(412) 777-3024
FACSIMILE PHONE NUMBER:
(412) 777-3902
jdg/mrozinski/jem037